

Appln No. 09/880,714

Amdt date May 3, 2005

Reply to Office action of December 3, 2004

REMARKS/ARGUMENTS

Claims 1-3 and 5-23 are currently pending in this application. Claim 22 has been amended. The amendment finds full support in the original specification, claims, and drawings. No new matter has been added. In view of the above amendment and remarks that follow, reconsideration and an early indication of allowance of claims 1-3 and 5-23 are respectfully requested.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant submits that the amendment to claim 22 now overcomes the rejection. Withdrawal of the rejection under 35 U.S.C. 112, second paragraph is therefore respectfully requested.

Claims 1, 9-10, 14, 17-19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bala et al. (U.S. Patent No. 6,335,992) in view of Marmur (U.S. Patent No. 6,466,886). Claims 2-3, 5-8, 11-13, 15-16, 20-21, and 23 are rejected under U.S.C. 103(a) as being unpatentable over Bala et al. and Marmur in further view of one or more of Sahasrabuddhe et al. (U.S. Patent Pub. 2002/0159114), Levine et al. (U.S. Patent No. 6,668,106), Grann (U.S. Patent No. 6,396,978), Zadikian et al. (U.S. Patent No. 6,631,134), Gersbach et al. (U.S. Patent No. 5,371,766), and Okano (U.S. Patent 6,449,074). Applicant respectfully traverses these rejections.

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In section 13 of the Final Office action, the Examiner contends that "Bala et al. and Marmur clearly teach a network node capable of handling different data-protocols in the same way as [the] instant specification." In support, the Examiner points out that "it is well known in the art that space switch is protocol independent, i.e., space switch can handle any protocol". (Id.; emphasis added). Applicant respectfully submits that "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." M.P.E.P. § 2144.03 (relying on In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001)). In Zurko, the Federal Circuit stated that "the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." (Id.) While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." (Id. at 1385).

Applicant respectfully submits that the issue of whether the cited references teach a switch architecture which permits multi-protocol electrical channel signals converted from a demultiplexed WDM optical signal to be switched using an electrical switching unit is not a peripheral issue, and the

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Examiner has failed to provide any form of evidence in the record to support the assertion.

Contrary to the Examiner's contention, Applicant respectfully submits that the switch architecture disclosed in Bala et al. is not one which permits multi-protocol electrical channel signals converted from a demultiplexed WDM optical signal to be switched using an electrical switching unit.

Firstly, and most importantly, the switch disclosed in Bala is not a space switch. Rather, as specifically mentioned in Applicant's Amendment dated August 23, 2004, the electrical switching fabric disclosed in Bala is one that includes timing processing, as is specifically disclosed in e.g. column 7, line 19 to 59, and is further unambiguously evident from table 2 in Bala, which specifies the specific fabric data rate for each of the described architectures. In other words, Bala discloses a STS (space time space) or VC (virtual container) switch for SDH/SONET cross connect switching. Bala does not disclose a space switch architecture.

Furthermore, and again as submitted by Applicant in the Amendment dated August 23, 2004, Bala itself clearly discloses that their electrical switching architecture does not permit multi-protocol electrical switching. Rather, Bala specifically mentions that if multi-protocol capabilities are required, the electrical switch fabrics disclosed (Figures 5A and 5B) must be replaced by the architecture disclosed in Figure 5C, that is an architecture in which an optical switch fabric 120 provides the multi-protocol switching capability. This is not an electrical multi-protocol switching capability. Applicant respectfully

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directs the Examiner to e.g. column 12, line 11 to 21, where the format and/or bit rate transparency is clearly disclosed as an advantage of the electrical/optical architecture shown in Figure 5C, only.

For completeness, Applicant also respectfully submits that the statement by the Examiner as to a modification of Bala that is "well known in the art" is not substantiated. Indeed, from the cited prior art it is clear that what was known at the relevant time was that multi-protocol switching capabilities can not be provided using an electrical switching unit, thus making the present invention non-obvious over the cited prior art. Applicant respectfully submits that it is only through the impermissible use of the hindsight gleaned from reading the present application that someone skilled in the art could read Bala et al., alone or in combination with the other cited references, and arrive at Applicant's claimed invention. However, it is well settled that the suggestion or motivation to make the combination or modification must be found in the prior art, and not in Applicant's own disclosure. M.P.E.P. § 2143.

Applicant further respectfully submits that there would thus be no motivation whatsoever for a skilled person to combine Marmur (US 6,466,886) with Bala so as to arrive at the present invention. It is well-settled that an Examiner must also show "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." M.P.E.P. § 2143. The Examiner here fails to point to any objective evidence for such modification. The

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STS or VC electrical switch in Bala, first of all, does not provide multi-protocol capabilities, and secondly, can not be modified by the addition of Marmur to do so. Accordingly, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness.

In view of the above amendments and remarks, Applicant respectfully submits that claims 1-3 and 5-23 are now in condition for allowance. Therefore, reconsideration of the claim rejections and an early indication of allowance of claims 1-3 and 5-23 are respectfully requested.

Respectfully submitted,

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